

REMARKS

In view of the following remarks, the examiner is respectfully requested to withdraw the rejections and allow Claims 1 to 26, the only claims pending and currently under examination in this application.

Claims 1, 12, and 24 have been amended primarily to clarify the claim language. It is sincerely believed that no new matter has been introduced by these amendments. The remaining amendments have been made to correct typographical errors. As no new matter has been added by the above amendments, their entry by the Examiner is respectfully requested.

Rejections under 35 U.S.C. § 112, 2nd ¶

Claims 1-7, 9-19, 21-24 and 26 were rejected for a number of issues under this section. In view of the above amendments, it is believed that this rejection may be withdrawn.

Rejections under 35 U.S.C. § 112, 1st ¶

Claims 1-5, 7-17 and 19-26 were rejected for under this section for an asserted lack of sufficient written description in the specification. Following entry of the above amendments, the claims require the use of a pair of complementary nucleotide analogs that have a reduced ability to base pair with each other, and yet can base pair with their complementary naturally occurring nucleotides. Extensive description and multiple representative examples of such pairs of nucleotide analogs is provided in the specification from page 17, line 5 to page 18, line 19, and from page 22 to 29. In view of the above amendments and the extensive discussion provided in the specification, it is believed that this rejection may be withdrawn.

Rejections under 35 U.S.C. § 102(e)

Claims 1-5, 7-17 and 19-26 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Vivekananda.

The claimed invention is directed to a method of enzymatically producing nucleic acids using nucleotide precursors that include at least one pair of complementary precursors, e.g., "C" and "G" analogs or "A" and "T" analogs, where the complementary precursors have a reduced ability to base pair with each other but can still base pair with their complementary naturally occurring nucleotides.

It is well established that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987), cert. denied, 481 U.S. 1052 (1987). See also, Scripps Clinic and Research Foundation v. Genentech, Inc., 18 USPQ 2d 1001 (Fed. Cir. 1991).

Upon careful review of the Vivekananda reference, including the specific sections cited by the Examiner, no teaching can be found of any method where one must specifically **employ a pair of nucleotide analogs**, as claimed in the presently claimed methods. Accordingly, the Vivekananda reference at least fails to teach this element of the claimed methods.

Because Vivekananda at least fails to teach this element of the claimed methods, Claims 1-5, 7-17 and 19-26 are not anticipated under 35 U.S.C. § 102(e) by Vivekananda and this rejection may be withdrawn.

Finally, Claims 1-26 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Kuttyavin.

As explained above, the claimed invention is directed to a method of

enzymatically producing nucleic acids using nucleotide precursors that include at least one pair of complementary precursors, e.g., "C" and "G" analogs or "A" and "T" analogs, where the complementary precursors have a reduced ability to base pair with each other but can still base pair with their complementary naturally occurring nucleotides.

It is well established that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987), cert. denied, 481 U.S. 1052 (1987). See also, Scripps Clinic and Research Foundation v. Genentech, Inc., 18 USPQ 2d 1001 (Fed. Cir. 1991).

Upon careful review of the Kutyavin reference, including the specific sections cited by the Examiner, no teaching can be found of any method where one must specifically **employ a pair of nucleotide analogs**, as claimed in the presently claimed methods. Accordingly, the Kutyavin reference at least fails to teach this element of the claimed methods.

Because Kutyavin at least fails to teach this element of the claimed methods, Claims 1-26 are not anticipated under 35 U.S.C. § 102(e) by Kutyavin and this rejection may be withdrawn.

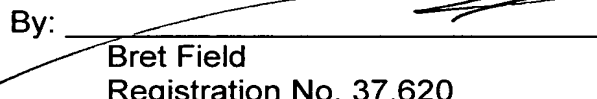
CONCLUSION

It is respectfully submitted that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078.

Respectfully submitted,
BOZICEVIC, FIELD & FRANCIS LLP

Date: 2/02/04

By: 
Bret Field
Registration No. 37,620

BOZICEVIC, FIELD & FRANCIS LLP
200 Middlefield Road, Suite 200
Menlo Park, CA 94025
Telephone: (650) 327-3400
Facsimile: (650) 327-3231